

## **REMARKS**

### **Status Of Application**

Claims 1-11 are pending in the application; the status of the claims is as follows:

Claim 9 is rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement.

Claim 9 is rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

Claims 1, 3, 4, 6, and 7 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,274,504 to Itoh ("Itoh").

Claims 1, 2, 5, 8, 10, and 11 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,040,949 to Ohno ("Ohno").

The acknowledgement, in the Office Action, of a claim for foreign priority under 35 U.S.C. § 119(a)-(d), and that the certified copy of the priority document has been received, is noted with appreciation.

The indication, in the Office Action, that the Examiner has no objections to the drawings filed on March 29, 2004 and September 22, 2004, is noted with appreciation.

### **Claim Amendments**

Claims 1, 10, and 11 have been amended to more particularly point out and distinctly claim the invention. These changes do not introduce any new matter.

Claim 9 has been amended to correct a typo-graphical error. These changes are not necessitated by the prior art, are unrelated to the patentability of the invention over the prior art, and do not introduce any new matter.

**35 U.S.C. § 112 Rejections**

The rejection of claim 9 under the first paragraph of 35 U.S.C. § 112 as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, is respectfully traversed based on the following:

Claim 9 has been amended to correct the ratio of the formula. Instead of “fw/ft,” the correct ratio is “ft/fw.” Claim 9, as corrected is supported at paragraph [0056] of the specification, which discloses that the condition  $(2) 2.3 \leq \text{ft/fw} \leq 5.5$  “defines the zoom ratio of the zoom lens system” and paragraph [0056], which further discloses that a zoom ratio of the zoom lens system is between 3 and 4, which satisfies the condition  $2.3 \leq \text{ft/fw} \leq 5.5$ . Applicants respectfully submit that claim 9, as corrected, is fully supported by the specification.

Accordingly, it is respectfully requested that the rejection of claim 9 under the first paragraph of 35 U.S.C. § 112 as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, be reconsidered and withdrawn.

The rejection of claim 9 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, is respectfully traversed based on the following:

As noted above, claim 9 has been corrected. Applicants respectfully submit that claim 9, as corrected, is fully supported by the specification.

Accordingly, it is respectfully requested that the rejection of claim 9 under the second paragraph of 35 U.S.C. § 112 as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention, be reconsidered and withdrawn.

**35 U.S.C. § 102(b) Rejection**

The rejection of claims 1, 3, 4, 6, and 7 under 35 U.S.C. § 102(b) as being anticipated by Itoh, is respectfully traversed based on the following:

Claims 1, 3, 4, 6, and 7 disclose a zoom lens system. One limitation in Claim 1 claims that “the following condition is satisfied:  $3 < | fl/fw |$  , where fl is a focal length of the most image side lens unit, and fw is a focal length of the zoom lens system in a shortest focal length condition.” The Office Action rejects claim 1 as being anticipated by Itoh (U.S. Patent No. 5,274,504). In rejecting claim 1, the Office Action states that Itoh discloses a zoom lense unit “wherein the following condition is satisfied:  $3 < | fl/fw |$  where fl is a focal length of the most image side lens, and fw is a focal length of the zoom lens system in a shortest focal length condition (See Itoh Table 1).” Applicants, disagree with this assertion because fl (f “one”) in Itoh is not the same as fl (f “ell”)in the claims at hand.

Table 1 of Itoh states that F1/FW in Numerical examples 1 and 2 equal -4.2 and -3.2, respectively. However, Itoh states that F1 is the focal length of the most object side lens unit (3: 30-31). However, the fl of claim 1 is defined as “a focal length of the most image side lens unit.” Thus, F1 of Itoh is the focal length of the most object side lens unit while fl of claim 1 is the focal length of the most image side lens unit. The examples of Itoh are for a completely different parameter and do not anticipate the limitations of claim 1.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” MPEP 2131. Thus, the cited reference does not anticipate claim 1 and claim 1 is patentably distinct from the prior art. Claims 3, 4, 6, and 7 are dependent upon claim 1, and thus include every

limitation of claim 1. Therefore, the cited reference does not anticipate claims 3, 4, 6, and 7 and claims 3, 4, 6, and 7 are patentably distinct from the prior art.

Accordingly, it is respectfully requested that the rejection of claims 1, 3, 4, 6, and 7 under 35 U.S.C. § 102(b) as being anticipated by Itoh, be reconsidered and withdrawn.

**35 U.S.C. § 103(a) Rejection**

The rejection of claims 1, 2, 5, 8, 10, and 11 under 35 U.S.C. § 103(a), as being unpatentable over Ohno, is respectfully traversed based on the following:

Claims 1, 2, 5, and 8 disclose a zoom lens system. One limitation in Claim 1 claims “a following lens unit having at least a third lens unit and a fourth lens unit and having at least a positive lens element and a negative lens element in a lens unit.” The Office Action rejects claim 1 as being obvious over Ohno (U.S. Patent No. 6,040,949). In rejecting claim 1, the Office Action asserts that Ohno discloses

a first lens unit disposed on a most object side and having a negative optical power; a second lens unit having a positive optical power; and a third lens unit including a most image side lens unit having at least a positive lens element and a negative lens element, (See Ohno figure 1 groups 1-3).

Claim 10 discloses an image capturing device. One limitation in Claim 10 claims “a following lens unit having at least a third lens unit and a fourth lens unit and having at least a positive lens element and a negative lens element in a lens unit.” The Office Action rejects claim 10 as being obvious over Ohno (U.S. Patent No. 6,040,949). In rejecting claim 10, the examiner asserted that Ohno discloses

[a]n electric image sensor converting an optical image formed by the zoom lens system, into electric image data, (Ohno teaches that zoom lens is used in concert with CCD) and a zoom lens system, said zoom lens system comprising, a first lens unit disposed on a most object side and having a negative optical power; a second lens unit having a positive optical power; and a third lens unit including a most image side lens unit having at least a positive lens element and a negative lens element, (see Ohno figure 1).

Claim 11 discloses a digital camera. One limitation in Claim 11 claims “a following lens unit having at least a third lens unit and a fourth lens unit and having at least a positive lens element and a negative lens element in a lens unit.” In rejecting claim 11, the Office Action asserts that Ohno discloses

[a]n electric image sensor converting an optical image formed by the zoom lens system, into electric image data, (Ohno teaches that zoom lens is used in concert with CCD) and a zoom lens system, said zoom lens system comprising, a first lens unit disposed on a most object side and having a negative optical power; a second lens unit having a positive optical power; and a third lens unit including a most image side lens unit having at least a positive lens element and a negative lens element, (see Ohno figure 1).

It is respectfully submitted that Ohno does not teach or suggest every limitation of claims 1, 10, and 11, as amended.

It is respectfully submitted that, at the least, Ohno does not teach or suggest the claims 1, 10, and 11 limitation claiming “a following lens unit having at least a third lens unit and a fourth lens unit and having at least a positive lens element and a negative lens element in a lens unit.” Ohno discloses at 6:51-62 that a first embodiment of the simple wide-angle zoom lens has only three lens groups. Ohno discloses at 8:30-33 that a second embodiment of the simple wide-angle zoom lens has only three lens groups. Ohno discloses at 10:34-36 that a third embodiment of the simple wide-angle zoom lens has only three lens groups. In fact, Ohno does not teach four lens units anywhere in the specification or the claims. As a result, it is respectfully submitted that Ohno does not teach “a following lens unit having at least a third lens unit and a fourth lens unit and having at least a positive lens element and a negative lens element in a lens unit.” Therefore, Ohno does not teach or suggest every limitation of claims 1, 10 and 11. “To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” MPEP 2143.03. Therefore, Ohno does not support a *prima facie* case for obviousness of claims 1, 10, and 11, and claims 1, 10 and 11 are patentably distinct from the prior art. Claims 2, 5, and 8 are dependent upon claim 1 and thus include every limitation of claim 1. Therefore,

the cited references also do not support a *prima facie* case for obviousness of claims 2, 5 and 8, and claims 2, 5 and 8 are patentably distinct from the prior art.

Accordingly, it is respectfully requested that the rejection of claims 1, 2, 5, 8, 10, and 11 under 35 U.S.C. § 103(a) as being unpatentable over Ohno, be reconsidered and withdrawn.

### **CONCLUSION**

Wherefore, in view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and an early reconsideration and a Notice of Allowance are earnestly solicited.

This Amendment does not increase the number of independent claims, does not increase the total number of claims, and does not present any multiple dependency claims. Accordingly, no fee based on the number or type of claims is currently due. However, if a fee, other than the issue fee, is due, please charge this fee to Sidley Austin LLP Deposit Account No. 18-1260.

If an extension of time is required to enable this document to be timely filed and there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed.

Application No.10/812,190  
Amendment dated November 6, 2007  
Reply to Office Action of August 6, 2007

Any other fee required for such Petition for Extension of Time and any other fee required by this document pursuant to 37 C.F.R. §§ 1.16 and 1.17, other than the issue fee, and not submitted herewith should be charged to Sidley Austin LLP Deposit Account No. 18-1260. Any refund should be credited to the same account.

Respectfully submitted,

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